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REMARKS

The Applicant wishes to thank the Examiner for the careful consideration of the application.

Claims 1 – 20 were in the application. Claims 1, 3 – 5, 8, 10-12, 15, and 17 – 18 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by Lloyd et al. (U.S. Patent 5,852,462). Claims 2, 9, and 16 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lloyd et al. in view of Gwaltney (U.S. Patent 5,751,432). Claims 6 – 7, 13 – 14, and 19 – 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lloyd et al. in view of Ng (U.S. Patent 5,234,783).

Independent claims 1, 8, and 15 have been amended to incorporate limitations from dependent claims 5, 12, and 18, respectively, and claims 5, 12, and 18 have been canceled. Thus, claims 1 – 4, 6 – 11, and 13 – 20 remain in the application. The rejections as applied to the claims as amended are traversed.

The §102 Standard

According to the MPEP §2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim.

Anticipation is a legal term of art. The applicant notes that in order to provide a valid finding of anticipation, several conditions must be met: (i) the reference must include every element of the claim within the four corners of the reference (see MPEP §2121); (ii) the elements must be set forth as they are recited in the claim (see MPEP §2131); (iii) the teachings of the reference cannot be modified (see MPEP §706.02, stating that "No question of obviousness is present" in conjunction with anticipation); and (iv) the reference must enable the invention

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as recited in the claim (see MPEP §2121.01). Additionally, (v) these conditions must be simultaneously satisfied.

The §102 rejections of claims 1, 3 – 5, 8, 10-12, 15, and 17 – 18 are respectfully traversed. Specifically, the PTO and Federal Circuit provide that §102 anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). The corollary of this rule is that the absence from a cited §102 reference of any claimed element negates the anticipation. *Kloster Speedsteel AB, et al. v. Crucible, Inc., et al.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). This MPEP section further states that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)."

With the amendment of the independent claims, all the remaining claims in the application include the limitation of "wherein varying at least one parameter includes varying at least one parameter chosen from a list consisting of: Nip Geometry; Auxiliary Heat; or Number of Passes". Although the Examiner indicates in the office action that Lloyd et al. discloses varying nip geometry, auxiliary heat, or number of passes, the Applicant believes the Examiner is in error, and that Lloyd in fact does not disclose controlling gloss by varying any of these three parameters. Furthermore, the Applicant is also unable to find disclosure of controlling gloss by varying one of these parameters in the other references cited by the Examiner. The rejections under §102 should therefore be withdrawn.

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The §103 Rejections

In rejecting claims 2, 6 – 7, 9, 13 – 14, 16 and 19 – 20 under 35 U.S.C. §103(a), the Examiner relied upon Lloyd et al. as disclosing the element of varying one of the parameters of nip geometry, auxiliary heat, or number of passes. As stated above, the Applicant believes that Lloyd in fact does not disclose varying any of these parameters, and that the other cited references also fail to disclose varying any of these parameters. The Applicant therefore believes that the Examiner has failed to state a prima facie case for obviousness, and therefore the §103 rejections must also be withdrawn.


The Applicant believes that the claims of the application as amended are allowable, and favorable action by the Examiner is respectfully requested.

Respectfully submitted,

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